



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/145,180	09/01/98	LI J	23356-M5

NIXON & VANDERHYE P.C.,
1100 NORTH GLEBE ROAD
8TH FLOOR
ARLINGTON VA 22201

HM12/1221

EXAMINER

MCCARTHY III, T

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 12/21/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/145,180

Applicant(s)
Li et al.

Examiner
McCarthy, T.C.

Group Art Unit
1618



☒ Responsive to communication(s) filed on Sep 1, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-183 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-183 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-98, drawn to a compound and pharmaceutical composition, class and subclass will vary depending on how the variable groups are defined.
 - II. Claims 99-155, drawn to a method of using compounds, class and subclass will vary depending on how the variable groups are defined.
 - III. Claims 156-183, drawn to a method for making compounds, class and subclass will vary depending on the compound being made.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used as an antiviral agent (US Patent 3,932,643 discloses compounds whose formulas meet the limitations of the current compound claims, and teaches the use of these compounds as antiviral agents).

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4. Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made using any of an infinite number of art known methods (i.e. solid phase or solution combinatorial syntheses, or classical serial synthesis using a variety of starting materials, etc.).

5. Inventions II and III are different. The steps and reagents required to practice inventions II and III are different, the reasons for practicing the two inventions are different, and the practice of invention II does not result in the production of the compounds in group I. Therefore art reading on one process would not read on the other and restriction is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. However, some of the above distinct inventions fall within the same class and subclass. In these cases, restriction is also proper because of the reasons listed above, and because these inventions have acquired a separate status in the art due to their recognized divergent subject matter.

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Election of Species

7. This application contains claims directed to the following patentably distinct species of the claimed invention: compounds, methods/forms of delivering compounds (claims 72-76 and 135-137), and diseases treated by the use of the compounds. Each of the compounds described by the claims found in group I have different structures such that art reading on one would not render the others obvious absent ancillary art. Each of the methods of delivery for the compounds involve different formulations/materials/methods such that art reading on one would not render the others obvious. Each of the diseases treated by the use of the claimed compounds have different symptoms and effect different tissues such that art reading on one method of treating would not render the others obvious. Therefore requirement for election of species is proper.

Should applicant elect either inventions I or II, a further election is required with respect to a single, specific compound (i.e. wherein all of the variable functional groups are defined), a single mode of delivery (i.e. a tablet with a single dose), and a specific disease for which the compound is to be used in treatment (i.e. Alzheimer's disease).

Should applicant elect invention III, a further election is required with respect to a single, specific compound being produced.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held

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to be allowable. Currently, claims 1, 37, 79, 86, 89, 91, 93, 94, 95, 97, 99, 139, 145, 148, 150, 152, 153, 154, and 156 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. A telephone call was made to Nancy Linck on December 8, 1999 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T.C. McCarthy whose telephone number is (703) 308-5316. The examiner can normally be reached on from to .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Adams, can be reached on (703) 308-0570. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7924.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


KEITH D. MACMILLAN
PRIMARY EXAMINER

T.C. McCarthy III

December 7, 1999